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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,371	06/19/2001	Shuji Shichi	PNDF-01078	1070

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,371

Applicant(s)

SHICHI, SHUJI

Examiner

Harish T. Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-15 are cancelled.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-21 and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over KWAN (US 2003/0200179) in view of Novoa et al. (hereinafter Novoa –US 6,636,973).

Re. Claim 16, KWAN discloses providing a user with a prepaid card linked to a database [para. 20]: and
executing an action chain including validating the prepaid card by comparing a user-input password number, input by the user, with a current password number stored in the database [claim 5; para 0021], and after the first validation of the prepaid card, validation of the prepaid card requires successful comparison of a currently user input password number to the stored current password number [claim 5].

KWAN does not explicitly disclose wherein, a different user-input password number and a different current password number is required for each of plural transactions,

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a first validation of the prepaid card uses a system-set first-time password number stored on the database as the current password number, after each validation, the user sets a new user-set password number as the current password number stored in the database. However Novoa discloses this feature [abstract; col. 2 lines 27-49; col. 3 lines 6-25] to increase the security for unauthorized access to the account (pre-paid card). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of KWAN and include a different user-input password number and a different current password number is required for each of plural transactions, a first validation of the prepaid card uses a system-set first-time password number stored on the database as the current password number as disclosed by Novoa, to improve the security of access and preventing unauthorized use of the card.

Re. Claim 17, KWAN discloses wherein the prepaid card is a virtual card [para 09; 05; 18].

Re. Claim 18, KWAN discloses the prepaid card comprises a physical card carrying duplicate information carried in the database, the prepaid card comprises a serial number, the first-time password number, and an expiration date printed on an exterior surface of the physical card, and the database comprises the serial number, the first-time password number, and the expiration date of the prepaid card [Figure 1; para 21; 63; claim 1]

Re. Claim 19, KWAN discloses the first-time password number is concealed below of scratch-off covering [Figure 5; para 21].

Re. Claim 20 KWAN discloses the database includes a database record corresponding to the prepaid card and comprising a serial number field storing a system-assigned serial number, a first-time password number field storing the system-assigned first-time password number used for a first time validation of the prepaid card, and a user-set password number field for storing the user-set password number reset as the current password number by the user subsequent to each validation of the prepaid card, a monetary balance field storing a monetary balance available to the user [Figures 2-3; para 19-21; claim 8;], and comprising the further step of: subsequent to the validation of the prepaid card, a action of subtracting a price being necessary for distribution from monetary balance field to update the monetary balance field by reducing a value of the monetary balance field by the price being subtracted [para 21; 32-35; claim 5].

Re. Claim 21 KWAN discloses an issue date field, an expiration date field, a card monetary face value field, a transaction product/service number field , and a transaction date field, each having a one-to-one correspondence with the prepaid card [Figures 4-5; para 75; 93; 69].

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Re. Claim 30, KWAN discloses executing an action chain including validating a user's card by comparing a user-input password with a current password stored in a database [claim 5; para 0021], and a first validation of the card uses a system-set first-time password stored on the database as the current password [para. 19-21]. KWAN does not explicitly disclose wherein, a different user-input password and a different current password is required for each validation of the card, and after each validation, the user sets a new user-set password as the current password stored in the database, and after the first validation of the card, subsequent validation of the card requires successful comparison of a currently input user input password to the stored current password in the database. However, Novoa discloses these features [Abstract; Figures 3-4; col. 8 lines 18-56] to increase the security for unauthorized access to the account. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of KWAN and include wherein, a different user-input password and a different current password is required for each validation of the card, and after each validation, the user sets a new user-set password as the current password stored in the database, and after the first validation of the card, subsequent validation of the card requires successful comparison of a currently input user input password to the stored current password in the database, as disclosed by Novoa, to improve the security of access and preventing unauthorized use of the stole or lost card.

Re. Claim 31, KWAN discloses the card comprises a physical card carrying duplicate information carried in the database [Figure 1; para 21; 63; claim 1], and

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the card each comprises a serial number, the first-time password number, and an expiration date printed on an exterior surface of the physical card [Figure 1; para 21; 63; claims 1 & 4].

Re. Claim 32, KWAN discloses the database includes a database record corresponding to the card and comprising a serial number field storing a system-assigned serial number, a first-time password field storing the system-assigned first-time password used for a first time validation of the card, and a user-set password field for storing the user-set password reset as the current password number by the user subsequent to each validation of the card, a monetary balance field storing a monetary balance available to the user, and comprising the further step of: subsequent to the validation of the card, a action of subtracting a transaction' price for distribution to a vendor from the monetary balance field to update the monetary balance field by reducing a value of the monetary balance field by the price being subtracted [Figures 2-3; para 19-21; 32-35; claims 5 & 8].

Re. Claim 21 KWAN discloses an issue date field, an expiration date field, a card monetary face value field, a transaction product/service number field, and a transaction date field, each having a one-to-one correspondence with the card [Figures 4-5; para 75; 93; 69].

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Re. Claims 34-35, Novoa further discloses a portal site, located between a user and the database, receiving from the user an input of the card serial number and the currently user input password; the portal accessing the database and validating the card by comparing the received user-input password with the current password stored on the database, and after validation of the card, the portal site i) requests the user to input the new user-set password, ii) receives the new user-set password from the user, iii) sends the received new user--set password to the database to be stored, in the user-set password field, as the current password required for a next validation of the card [Abstract; col. 2 lines 27-49; col. 3 lines 6-25] to increase the security for unauthorized access to the account since the current pre-paid card have code printed on them and any one can use it if the card is lost or stolen. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Kwan, Novoa and Rubin and include provisioning for the user to reset password for enhancing the security of the pre-paid card and storing the new password in database for validation of the card to prevent fraud and misuse of the customer pre-paid account.

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Claim 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over KWAN and Novoa as it applied to claims 16 and 20 above, further in view of Rubin et al (hereinafter Rubin – US 6,701,522).

Re. Claims 22-24, KWAN discloses located between a user and the database, receiving from the user an input of the card serial number and the currently user input password number; the portal accessing the database and validating the prepaid card by comparing the received user-input password number with the current password number stored on the database [claim 1], and wherein the portal site is connected to the user and to the database via the Internet and wherein the portal site is connected to the user via a telephone line and (see use of internet and telephone for activation) [para. 60; claim 1]. KWAN does not explicitly disclose portal, or a portal site. However, Rubin discloses this feature [see Abstract; Figures 1-2, 7; col. 1 lines 5-50] to allow a user(s) (purchaser) to customize interested websites, which will be automatically retrieved and display information the user is seeking. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of KWAN and include portal, as disclosed by Rubin, to allow the user to configure its favorites website for obtaining information or purchases.

Re. Claim 25, KWAN discloses wherein the user orally inputs the password number to the portal [para. 60].

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Re. Claim 26, KWAN does not explicitly disclose the portal site further receives user input of the serial number and confirms the expiration date of the prepaid card to the database prior to validating the prepaid card. However, this function is well known function of using credit cards. For example, when a customer orders a product online or by phone the merchant asks these question to properly charge the customer as-will-as validates the card. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kwan, Novoa and Rubin and include this function to enhance the security of the card in case it is used improperly.

Re. Claims 27-28, Novoa further discloses after validation of the prepaid card, the portal site i) requests the user to input the new user-set password number, ii) receives the new user-set password number from the user, iii) sends the received new user-set password number to the database to be stored, in the user-set password number field, as the current password number required for a next validation of the prepaid card and a next successful validation of the prepaid card requires the portal site i) to receive from the user another password number input, 'and ii) to successfully compare the received another password number input with the current password number stored in the user-set password number field of the record of the prepaid card within the database. However Novoa discloses these features [Abstract; col. 2 lines 27-49; col. 3 lines 6-25] to increase the security for unauthorized access to the account since the current pre-paid card have code printed on them and any one can use it if the

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card is lost or stolen. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Kwan, Novoa and Rubin and include provisioning for the user to reset password for enhancing the security of the pre-paid card and storing the new password in database for validation of the card to prevent fraud and misuse of the customer pre-paid account.

Re. Claim 29, KWAN discloses wherein the user orally inputs the password number to the portal site and the portal site orally responds to the user, via a telephone call [para. 60].

Response to Arguments

2. Applicant's arguments with respect to pending (new claims) have been considered and new ground of rejection is presented.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US 6,202,155 (Tushie et al.) discloses a virtual card personalization system uses a plurality of virtual devices to control physical personalization equipment to produce a physical transaction card as defined by a transaction card configuration and personalization data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
Art Unit 3693

9/1/06


ELLA COLBERT
PRIMARY EXAMINER